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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/705,125	11/01/2000	Hitoshi Miyasaka	EITCP003HO	4127

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EXAMINER

CAMPBELL, JOSHUA D

ART UNIT	PAPER NUMBER
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2179

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/705,125	Applicant(s) MIYASAKA ET AL.	
	Examiner Joshua D Campbell	Art Unit 2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Request for continued examination filed on 11/22/2004.
2. Claims 31-40 are pending in this case. Claims 31, 35, and 37 are independent claims. Claims 1-30 have been cancelled. Claims 31-40 have been newly added.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 31-34 and 37-40 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim raises the question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment, or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. In order to overcome this rejection the claim language must provide a basis that the method steps are performed by a computer or machine, instead of being performed as a mental process.

Allowable Subject Matter

4. Claims 31-34 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101, set forth in this Office action.

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5. The following is a statement of reasons for the indication of allowable subject matter:

Regarding added independent claim 31, none of the references, either singularly or in combination, teach or suggest to a person of ordinary skill in the art at the time of the invention the amended features, "... applying a first mapping to obtain a first indication of categories that represents the one or more preferred categories in a form that conforms to a first hierarchical structure comprising topics, wherein the first mapping specifies a transformation between the topics and the subtopics in the base hierarchical structure to the topics in the first hierarchical structure... generating a first search requirements in response to the first indication of categories and using the first search requirements... applying a second mapping to obtain a second indication of categories that represents the one or more preferred categories in a form that conforms to a second hierarchical structure comprising topics, wherein the second mapping specifies a transformation between the topics and the subtopics in the base hierarchical structure to the topics in the second hierarchical structure... generating a second search requirements in response to the second indication of categories and using the second search requirements..." The examiner notes that while creating a personalized presentation of news based on user preferences is not a novel feature (See Examiner Referenced Patents), in combination with the other limitations of the method steps and system functions of the independent claim (i.e. applying a first mapping to obtain a first indication of categories that represents the one or more preferred categories in a form that conforms to a first hierarchical structure comprising topics, wherein the first

mapping specifies a transformation between the topics and the subtopics in the base hierarchical structure to the topics in the first hierarchical structure; generating a first search requirements in response to the first indication of categories and using the first search requirements; applying a second mapping to obtain a second indication of categories that represents the one or more preferred categories in a form that conforms to a second hierarchical structure comprising topics, wherein the second mapping specifies a transformation between the topics and the subtopics in the base hierarchical structure to the topics in the second hierarchical structure; generating a second search requirements in response to the second indication of categories and using the second search requirements) the limitations of claim 31 are considered novel, and unobvious to a person of ordinary skill in the art at the time the invention was made in view of the prior art of record.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 35 is rejected under 35 U.S.C. 102(e) as being anticipated by Nehab et al. (hereinafter Nehab, US Patent Number 6,029,182, issued on February 22, 2000).

Regarding independent claim 35, Nehab discloses a method in which a user generates a profile containing information including layout, sites to check, keywords, and types of articles to be used to create a personalized newspaper (column 9, 4-61 of Nehab). This profile is obtained and used to find (identify) documents and articles that fit into the user preferences (relevance based on keywords, type of article, topic of article, etc.) (column 8, line 10-column 9, line 61 of Nehab). Nehab discloses a method in which the articles that are deemed relevant based on the user profile are presented (generating a list) to the user and a format editor gives the user the ability to decide which articles are to be place in the newspaper and how they are to be laid out in the template (column 9, line 4-column 10, line 6 of Nehab). The articles that have been obtained because they were deemed relevant are then placed into a template based on the user's specification of layout (column 9, line 4-column 10, line 6 of Nehab). The articles can be generated corresponding to an layout that is to be printed via a print device and/or corresponding to a layout that is to be displayed via a display device (column 9, line 4-column 10, line 6 and column 10, lines 21-35 of Nehab). Both presentations are delivered when finished (column 9, line 4-column 10, line 6 and column 10, lines 21-35 of Nehab).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 36-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nehab et al. (hereinafter Nehab, US Patent Number 6,029,182, issued on February 22, 2000) as applied to claims 1, 10, and 19 above, and further in view of Ferguson (IDS, US Patent Number 5,649,186, issued on July 15, 1997).

Regarding dependent claim 36, Nehab discloses a method in which the articles that are deemed relevant based on the user profile are presented (generating a list) to the user and a format editor gives the user the ability to decide which articles are to be place in the newspaper and how they are to be laid out in the template (column 9, line 4-column 10, line 6 of Nehab). The articles that have been obtained because they were

deemed relevant are then listed in a template based on the user's specification of layout (column 9, line 4-column 10, line 6 of Nehab). Nehab does not disclose a method in which a direct indication of selected entries from the list of entries by the user is received. However, Ferguson discloses a method in which a list of topically organized articles is presented to a user and the user makes selections from that list to be included in the user's customized newspaper (column 4, lines 6-60 of Ferguson). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Nehab and Ferguson because it would have allowed the user to have complete control over specific content.

Regarding independent claim 37, Nehab discloses a method in which a user generates a profile containing information including layout, sites to check, keywords, and types of articles to be used to create a personalized newspaper (column 9, 4-61 of Nehab). This profile is obtained and used to find (identify) documents and articles that fit into the user preferences (relevance based on keywords, type of article, topic of article, etc.) (column 8, line 10-column 9, line 61 of Nehab). Nehab discloses a method in which the articles that are deemed relevant based on the user profile are presented (generating a list) to the user and a format editor gives the user the ability to decide which articles are to be place in the newspaper and how they are to be laid out in the template (column 9, line 4-column 10, line 6 of Nehab). The articles that have been obtained because they were deemed relevant are then placed into a template based on the user's specification of layout (column 9, line 4-column 10, line 6 of Nehab). Nehab does not disclose a method in which a direct indication of a measure of interest of a

user is received. However, Ferguson discloses a method in which a list of topically organized articles is presented to a user and the user makes a judgment on whether or not to include the article (measure of interest) (column 4, lines 6-60 of Ferguson). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Nehab and Ferguson because it would have allowed the user to have complete control over specific content.

Regarding dependent claims 38 and 39, Nehab does not disclose a method in which a direct indication of a measure of interest of a user is received for either articles that are already contained in the newspaper or articles that have been omitted. However, Ferguson discloses a method in which a list of topically organized articles is presented to a user, which includes all articles already chosen for the newspaper and omitted from the newspaper, and the user makes a judgment on whether or not to include the article (measure of interest) (column 4, lines 6-60 of Ferguson). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Nehab and Ferguson because it would have allowed the user to have complete control over specific content.

Regarding dependent claim 40, Nehab discloses a method in which the articles that are deemed relevant based on the user profile are presented (generating a list) to the user and a format editor gives the user the ability to decide which articles are to be place in the newspaper and how they are to be laid out in the template (column 9, line 4-column 10, line 6 of Nehab). The articles that have been obtained because they were deemed relevant are then listed in a template based on the user's specification of layout

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(column 9, line 4-column 10, line 6 of Nehab). Nehab does not disclose a method in which a direct indication of selected entries from the list of entries by the user is received. However, Ferguson discloses a method in which a list of topically organized articles is presented to a user and the user makes selections from that list to be included in the user's customized newspaper (column 4, lines 6-60 of Ferguson). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Nehab and Ferguson because it would have allowed the user to have complete control over specific content.

Response to Arguments

11. Applicant's arguments with respect to claims 35-40 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US Patent Number 6,253,188

US Patent Application Publication 2002/0040374


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D Campbell whose telephone number is (571) 272-4133. The examiner can normally be reached on M-F (8:00 AM - 4:30 PM).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JDC
January 31, 2005


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